



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

08/793,416

10/23/1997

JOHN THOMAS HARE

18872.0056

5267

25312 7590 02/15/2007
WILSONART INTERNATIONAL, INC.
C/O WELSH & FLAXMAN, LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA, VA 22314

EXAMINER

AWAI, ALEXANDRA F

ART UNIT

PAPER NUMBER

3663

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
--	-----------	---------------

3 MONTHS

02/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

08/793,416

Applicant(s)

HARE, JOHN THOMAS

Examiner

Alexandra Awai

Art Unit

3663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 November 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-26 and 30-38 is/are pending in the application.
- 4a) Of the above claim(s) 30-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1.. Applicant's arguments filed 11/20/2006 have been fully considered but they are not in every respect persuasive. Claims 20-26 and 30-38 are pending, claim 20 having been amended and claims 30-38 having been withdrawn. Those rejections that have been overcome by amendment are omitted from the present Office Action and are considered withdrawn.

In the most recent Remarks, Applicant asserts that the previous examiner has agreed that none of the primary references disclose a shield having an obliquely oriented, unsealed slit in conjunction with a cylindrical shield body as claimed. This appears to be the case. It is noted that Applicant raises no objections with regard to the other teachings gleaned from the references by the previous examiner, and Examiner takes this as an implicit admission that the only deficiency of the cited prior art is the obliquely oriented slit.

With regard to Applicant's opinion that the cited references fail to disclose or suggest that it is obvious to combine as many as 16 references in rendering the pending claims obvious, it is noted that none of the rejections under 35 U.S.C. 103(a) (sections 3, 4 and 5) of the Office Action dated 5/25/2004 requires anymore than three references, there being a number of alternative options for any one of the three references. Furthermore, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Regardless, the reasoning as set forth in this Office Action is intended to clarify the grounds of rejection of the presently amended claims.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 20-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 is indefinite because it fails to set forth the corresponding structural relationship between the cavity and the inner and outer faces. Indeed, the claim reads on an embodiment where these features are distinct from one another, and such an embodiment is not supported by the disclosure. The disclosed and elected embodiment is more accurately described as a cylindrical annulus.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

Art Unit: 3663

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 20-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinberger (GB 954,594), and further in view of either of Noel (4,576,846) or Fry et al. (4,748,060).

Weinberger discloses a shield body including a core layer comprising silicone rubber and particulate lead (Fig. 2, 10) located between two layers of silicone rubber with embedded fibers (Fig. 2, 16 and 18) that read on solid polymeric material. These teachings encompass the recited features of claims 21-24. As stated on page 3, lines 129 to 130, the core layer may be advantageously between 1-1.5 mm. However, if a permanently curved form is desired, a single thicker layer will be employed and molded to the desired form and cured to in the molded shape (p. 4, lines 6-9). This disclosure is a suggestion that renders the recited feature of claim 26 obvious where there exists a desire to employ a permanently curved form. With regard to the recited feature of claim 25, the figures clearly show that the thickness of the polymeric layers is about half of the disclosed 1-1.5 mm of the core layer. While patent drawings are not drawn to scale, relationships clearly shown in the drawings of a reference patent cannot be disregarded in determining the patentability of the claims. See *In re Mraz*, 59 CCPA 866, 455 F.2d 1069, 173 USPQ 25 (1972). It is therefore entirely within the purview of the skilled artisan to produce polymeric layers as claimed in claim 25 in order to meet the requirements of a given shielding application. The materials utilized within this prior art shield body are notoriously well known in the art, and the skilled artisan is capable of manipulating their shapes and compositions through routine experimentation within prior art conditions.

While Weinberger does suggest that the layered shield body may have a permanently curved form, the form recited in claim 20 is not specifically recited. Both Noel and Fry et al. are related to the analogous art of conforming duct coverings. Both teach resilient cylindrical coverings equivalent in configuration to shield bodies having a cavity dimensioned to receive a tubular element. As best seen from Figs. 4-6, 19 and 20 of Noel, the cylindrical covering comprises a slit extending from an inner to an outer face at an oblique angle relative to the radius of the shield body, the slit enabling the functionality recited in claim 20. Although the claims do not set forth that the slit is in the form of a flat plane, it is entirely within the ability of the skilled artisan to eliminate the tortuous nature of the disclosed slit configurations in order to simplify manufacture. Fry et al. disclose a slit enabling the functionality recited in claim 20 (Figs. 1 and 2) that is not at an oblique angle relative to the radius of the shield body. However, it would have been obvious to one of ordinary skill in the art to slant the slit in order to produce a greater surface area for adhesion without otherwise altering the configuration of the shield body, thus improving the sealing ability of the shield body using only widely available knowledge and means. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings regarding pipe coverings found in the secondary references with the shielding material teachings found in Weinberger in order to form a permanently curved shape as suggested by Weinberger for use as a pipe covering, for instance, while only using what is old and known.

Art Unit: 3663

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexandra Awai whose telephone number is (571) 272-3079.

The examiner can normally be reached on 9:30-6:00 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Keith can be reached on (571) 272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA
February 9, 2007


JACK KEITH
SUPERVISORY PATENT EXAMINER